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62

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,842	02/12/2001	Thomas J. Blakemore	D-2958	7727
33197	7590	01/06/2004	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			METZMAIER, DANIEL S	
4 VENTURE, SUITE 300			ART UNIT	
IRVINE, CA 92618			PAPER NUMBER	

1712

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,842	BLAKEMORE ET AL.	
	Examiner	Art Unit	
	Daniel S. Metzmaier	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-31, 33-42 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-42, 44, 45 and 47 is/are allowed.
- 6) ☒ Claim(s) 23, 33-37, 46 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 24-31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>122003</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 23-31, 33-42 and 44-53 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 23 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshlack et al. 5,472,712. Oshlack et al. (esp. Abstract; Example 28 referring to Example 26; column 2, lines 32-41 as to the amount of ethyl cellulose coating; column 4, lines 28-33; paragraph bridging columns 4 and 57 column 7, lines 53-59; paragraph bridging columns 13 and 14; and column 15, lines 12-21 and 36-57 as to the use of disinfecting agents or germicides such as calcium hypochlorite as the

"active" (e.g. in recreational or swimming pools), disclose and/or suggest controlled release additive compositions for use in open circulating cooling water systems (such as recreational or swimming pools) wherein the core active ingredient is a disinfecting agent or germicide such as calcium hypochlorite and the coating is made up of units of one monomer such as ethyl cellulose, and thus render them prima facie obvious. For example, it would have been obvious to one skilled in the art at the time applicants' invention was made to substitute calcium hypochlorite for the therapeutic acetaminophen in Examples 26 and 28 to prepare a controlled release disinfecting agent in view of the interchangeability of these actives in column 4*, lines 28-33. Note that in Example 28 of Oshlack et al., the weight percent of Methocel to the tablet cores is about 6%, and in Example 26, the tablet cores include a binder and a lubricant, which is presumably zinc stearate (a known die release agent) disclosed in column 15, line 47.

To the extent Oshlack et al differs from the claims in the use of a copolymer made up of units of only two different monomers, Oshlack et al (column 13, lines 12-13) teach the use of copolymers of polyvinyl chloride and acetonitrile. Said copolymer is a copolymer made up of units of only two different monomers. It would have been obvious to one skilled in the art at the time applicants' invention was made to employ the copolymers of polyvinyl chloride and acetonitrile taught in the Oshlack et al reference as an obvious functional equivalent to those exemplified therein.

4. Claims 46 and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshlack et al., 5,472,712, as applied to claims 23 and 32-37 above, and further in

view of Etani, 4,692,314. Oshlack et al discloses compositions as set forth in the above rejection.

Oshlack et al differs in the methods of specifically adding the chemicals to a cooling tower.

Etani (column 3, lines 14-20; column 10, line 28, to column 12, lines 17; and column 13, lines 16-33) discloses methods for treating water systems including swimming pools and cooling towers with polymer containing compositions, biocides, and corrosion inhibitors.

These references are combinable because they teach water treating compositions, delivery systems therefore and applications thereof. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the compositions of Oshlack et al added to a cooling tower taught to be conventional in the Etani reference.

Allowable Subject Matter

5. Claims 38-42, 44, 45 and 47 allowed.
6. Claims 24-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: attention is directed to paragraph 6 of the Office Action mailed June 5, 2003.

Response to Arguments

8. Applicant's arguments filed September 8, 2003 have been fully considered but they are not persuasive.
9. Applicants (pages 10-13) assert the Oshlack et al reference lacks a copolymer of only two monomers. This has not been deemed persuasive and has been addressed in the above rejections.
10. Applicant's arguments with respect to claims 46, 48 and 49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1089.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM